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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ZURITA, JAMES H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,584

Applicant(s)

ISTVAN, ANTHONY F.

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haines et al. (US Patent 6,233,409) in view of Cornelius (US Patent 6,629,081).

Haines discloses systems and methods for providing automatic prompting for printer ink refill of a printer connected to a communication device. Haines discloses facilitating an order for an ink refill product by **monitoring** printers for signals to refill ink (see, for example Col. 4, lines 1-37), **receiving** the signal associated with the printer (see, for example Col. 4, lines 50-65) and **notifying** a user of a communication device (such as a client terminal, personal computer) connected to the printer (see, for example Col. 2, lines 9-15, Col. 4, lines 44-65).

Haines discloses that the signal is generated by a sensor of the printer upon sensing a low level of ink (see, for example Col. 4, lines 4-55).

Haines discloses identifying the printer model and ink refill product for the printer (see, for example Col. 2, lines 1-8, Col. 3, lines 35-55).

Haines discloses retrieving information for the ink refill product for the printer from an information source and delivering the retrieved information to the

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communication device connected to the printer (see, for example, references to lookup tables, Col. 2, lines 28-39, Col. 4, lines 50-65).

Haines discloses that the communication device may comprise a computer device, and that the communication device comprises a network server in a computer network system. See, for example, Fig. 3 and related text for references to network and host computer.

Haines *does not* specifically disclose launching a web browser to provide on-line shopping to the user of the communication device. Haines facilitates a user's ordering by storing and displaying a vendor's URL. A URL is the global address of resources on the World Wide Web. To access and link to a URL on the WWW, it is common to launch a browser. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include launching a web browser to provide on-line shopping to the user of the communication device.

One of ordinary skill in the art at the time the invention was made would have been motivated to include launching a web browser to provide on-line shopping to the user of the communication device for the obvious reason that this is a convenience for a user since it permits a user to contact a vendor automatically. Additionally, this provides a vendor with an excellent opportunity to market subsequent toner cartridges to the user.

Haines *does not* disclose that delivering a user notification comprises sending an e-mail message to a user of the communication device. The use of email to send notification is old and notoriously well known. It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to include in Haines the use of e-mail messages to users at a communication device. One of ordinary skill in the art at the time the invention was made would have been motivated to include in Haines the use of e-mail messages to users at a communication device for the obvious reason that e-mail is a quick, efficient way of notifying someone across networks.

Haines *does not* disclose retrieving wallet information associated with a user of the communication device connected to the printer. Haines *does not* disclose displaying the retrieved information on the Internet-enabled television system in response to a subsequent user action. Cornelius discloses the use of wallets to perform e-commerce transactions such as ordering online. Cornelius also discloses the use of wallets with TV set-top Internet access devices. See, for example, col. 207, line 40-Col. 208, line 45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Haines with Cornelius to disclose retrieving wallet information and displaying retrieved information on an Internet enabled television system. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Hines with Cornelius to disclose retrieving wallet information and displaying retrieved information on an Internet enabled television system for the obvious reason that digital wallet software is already available on devices such as internet enabled set-top TV devices and the use of wallet software facilitates secure, online transactions between a user and a vendor.

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Cornelius *does not* disclose that delivering a user notification comprises superimposing the user notification over a television program displayed by an Internet-enabled television system. Cornelius *does not* disclose that superimposing a user notification comprises horizontally scrolling the superimposed notification in a ticker format. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine deliver notifications according to the devices on which the information will be displayed *to disclose* superimposing the user notification over a television program displayed by the Internet-enabled television system and horizontally scrolling superimposed notification in a ticker format.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine deliver notifications according to the devices on which the information will be displayed to disclose superimposing the user notification over a television program displayed by the Internet-enabled television system and horizontally scrolling superimposed notification in a ticker format for the obvious reason that users may find that convenient and pleasant formats and presentations such as tickers and superimposed images are user-friendly.

It is well known that users prefer easy-to-use commands and graphical interfaces to manage their files and data. Without such interfaces and extensions, users may feel overwhelmed or frustrated by having to enter obscure, non-intuitive operating system commands. Users who are unable to remember operating system commands may well avoid carrying on electronic commerce over the Internet or Internet enabled TV, for example. On the other

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hand, well-designed, intuitive interfaces permit users to feel comfortable in performing complex operations such as placing orders for re-plenishable goods.

Neither Haines nor Cornelius specifically disclose that

...retrieved information for the ink refill product comprises product, supplier, pricing, and shipping information.

...retrieved information for the ink refill product comprises product, supplier, pricing, and shipping information from a plurality of suppliers.

...information is delivered to the communication device by launching of a web browser configured to display the retrieved information from one or more websites.

...information is delivered to the communication device using a default format.

...information is delivered to the communication device using a format selected by a user of the communication device.

...format is selected from the group consisting of alerts, always-active formats, button-press-required formats, and e-mail notifications.

...type of information to be delivered to the communication device is preselected by a user of the communication device.

...communication device comprises an Internet-enabled television system.

...Internet-enabled television system provides a graphical user interface, and wherein delivering the user notification comprises displaying the user notification in a designated area of the graphical user interface.

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However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of facilitating, monitoring, receiving, notifying, generating a signal, identifying a printer, retrieving information, delivering the retrieved information, retrieving wallet information, displaying the retrieved information, delivering the user notification, superimposing the user notification, delivering a user notification, horizontally scrolling the superimposed notification would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use any type of data in the steps of facilitating, Monitoring, receiving, notifying, generating a signal, identifying a printer, retrieving information, delivering the retrieved information, retrieving wallet information, displaying the retrieved information, delivering the user notification, superimposing the user notification, delivering a user notification, horizontally scrolling the superimposed notification because such data *does not* functionally relate to the steps in the method claimed and because the subjective interpretation of the data *does not* patentably distinguish the claimed invention.

Haines, and Cornelius *do not* specifically disclose which functions are performed by specific components, such as ***a user notification component*** within the communication device configured to

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- automatically notify a user of the communication device in response to receipt of the ink refill signal.
- display the information in a designated area of the graphical user interface.
- superimpose the information over a television program displayed by the Internet-enabled television system.
- horizontally scroll the superimposed information in a ticker format.
- display a delivery notice on the Internet-enabled television system
- display the retrieved information on the Internet-enabled television system in response to a subsequent user action.
- send an e-mail message to the user.

information retrieval component configured to retrieve ink refill information for the printer.

information delivery component configured to deliver the retrieved information to the communication device in response to receipt of the ink refill signal.

communication channel reservation component configured to reserve a communication channel for delivery of information to the communication device.

on-line shopping component configured to facilitate on-line shopping of one or more ink refill products on the Internet.

user customization component configured to receive a user selection of a notification format for delivery of the information.

information delivery component configured to deliver the retrieved information to the communication device in response to receipt of the ink refill signal.

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However, the specific meaning/interpretation/functions of the components *does not* patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of components in the system taught by Haines and Cornelius because the subjective functions of the components *does not* patentably distinguish the claimed invention.

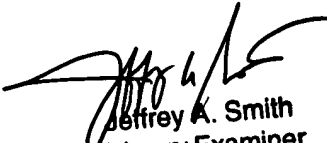
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynne Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-1113.

Jt
James Zurita
Patent Examiner
Art Unit 3625
5 December 2003


Jeffrey A. Smith
Primary Examiner